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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,546	05/22/2000	Nathalie Jager Lezer	05725.0588-00000	1552

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[REDACTED] EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/576,546</b>	Applicant(s) <b>Lezer</b>
	Examiner <b>Susan Tran</b>	Art Unit <b>1615</b>
		
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
<b>Period for Reply</b> A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul>		
<b>Status</b> <p>1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Jul 15, 2002</u></p> <p>2a) <input checked="" type="checkbox"/> This action is FINAL.      2b) <input type="checkbox"/> This action is non-final.</p> <p>3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i>, 1935 C.D. 11; 453 O.G. 213.</p>		
<b>Disposition of Claims</b> <p>4) <input checked="" type="checkbox"/> Claim(s) <u>1-7 and 14-32</u> is/are pending in the application.</p> <p>4a) Of the above, claim(s) _____ is/are withdrawn from consideration.</p> <p>5) <input type="checkbox"/> Claim(s) _____ is/are allowed.</p> <p>6) <input checked="" type="checkbox"/> Claim(s) <u>1-7 and 14-32</u> is/are rejected.</p> <p>7) <input type="checkbox"/> Claim(s) _____ is/are objected to.</p> <p>8) <input type="checkbox"/> Claims _____ are subject to restriction and/or election requirement.</p>		
<b>Application Papers</b> <p>9) <input type="checkbox"/> The specification is objected to by the Examiner.</p> <p>10) <input type="checkbox"/> The drawing(s) filed on _____ is/are a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).</p> <p>11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action.</p> <p>12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.</p>		
<b>Priority under 35 U.S.C. §§ 119 and 120</b> <p>13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</p> <p>a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of:</p> <ol style="list-style-type: none"> <li>1. <input type="checkbox"/> Certified copies of the priority documents have been received.</li> <li>2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.</li> <li>3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> </ol> <p>*See the attached detailed Office action for a list of the certified copies not received.</p> <p>14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).</p> <p>a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.</p> <p>15) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.</p>		
<b>Attachment(s)</b> <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____</p> <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p>		

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### **DETAILED ACTION**

Receipt is acknowledged of applicant's Information Disclosure Statement filed 05/22/00, Election filed 12/21/00, Request for Extension of Time filed 06/25/01, 02/04/02, and 07/15/02, Amendment A filed 06/25/01, Amendment B filed 11/05/01, Request for Continued Examination filed 02/04/02, and Request for Reconsideration filed 02/04/02 and 07/15/02.

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/04/02 has been entered.

#### ***Claim Rejections - 35 U.S.C. § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al.

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Arraudeau teaches an anhydrous cosmetic composition comprising fiber having length much greater than diameter (column 1, lines 11-62), propylene glycol dicaprylate, glycerol, and oils (column 2, lines 40 through column 3, lines 1-9; and examples 1, 2, 7, 8, 12, 13).

Regarding to claims 2 and 3, Arraudeau is silent as to the teaching of IOB value. However, Arraudeau discloses the use of the same polyol to obtain the same result, desire by the applicant, e.g., an anhydrous make-up formulation. Therefore, it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable IOB value and select a desirable polyol. The expected result would be an anhydrous make-up formulation that last long, and do not smear.

3. Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Yoshioka et al. JP 404159218A.

Arraudeau is relied upon for the reasons stated above. The reference is silent as to the teaching of IOB value.

Yoshioka teaches a gelatin capsule useful in the field of cosmetics comprising humectant having IOB value of 3.5, e.g., propylene glycol, polyethylene glycol, dipropylene glycol, or 1,3-butylene glycol (see abstract). Hence, it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's cosmetic composition using propylene glycol having IOB

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value of 3.5 in view of the teaching of Yoshioka. The reason for this modification is to obtain an anhydrous cosmetic composition capable of maintaining uniformity/stability for periods of time.

4. Claims 1-7, 15-18, 20, 23, 24, 26-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Japanese abstract from Shiseido JP 05320038A (JP 038).

Arraudeau is relied upon for the reasons stated above. The reference is silent as to the teaching of IOB value.

JP 038 teaches a cosmetic composition containing up to 10% water, and at least 3% of one or mixture of polyethylene glycol, and polyoxy compounds having IOB value of up to 3.5 (see abstract). Thus, it would have been *prima facie* obvious for one of ordinary skill in the art to modify Arraudeau's cosmetic composition using propylene glycol having IOB value of 3.5 in view of the teaching of JP 038. The reason for this modification is to obtain a very satisfactory anhydrous make-up composition useful in cosmetic art.

5. Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., and Franzke et al. US 5,965,146.

Arraudeau is relied upon for the reasons stated above. Regarding to claim 14, Arraudeau does not teach the claimed fiber.

Franzke teaches a cosmetic composition comprising polyamide fiber having diameter of 8 to 70  $\mu\text{m}$ , and length of between 20 to 2000  $\mu\text{m}$  (columns 1-2). Hence it would have been *prima*

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facie obvious for one of ordinary skill in the art to modify Arraudeau's fiber with polyamide fiber in view of the teaching of Franzke, because the references teach the advantageous results in the use of fibers. The expected result would be an anhydrous make-up formulation containing fiber useful for cosmetic fields.

6. Claims 14-22, and 25-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arraudeau et al., in view of Bara et al. US 6,177,091.

Arraudeau is relied upon for the reasons stated above. Arraudeau does not teach parleam oil.

Bara teaches an anhydrous cosmetic composition comprising fiber, and oils, e.g. parleam oil (columns 2-5). Thus, it would have been prima facie obvious for one of ordinary skill in the art to modify Arraudeau's oil using parleam oil in view of the teaching of Bara. The reason for this modification is to obtain an anhydrous cosmetic composition that prevents unaesthetic folds, migration, and thus provides long lasting property on skin or lips. The expected result would be an anhydrous make-up formulation containing fiber useful for cosmetic fields.

With regarding to the length and diameter of the fiber, it is the position of the examiner that it would have been obvious for one of the ordinary skill in this art to, by routine experimentation determine a suitable length and diameter of the fiber to obtain a desire anhydrous cosmetic formulation that will provide a long lasting appearance, and thus will not require repeated applications.

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***Response to Arguments***

7. Applicant's arguments filed 07/15/02 have been fully considered but they are not persuasive. The examiner maintains the original 103(a) rejections.

Applicant argues that Arraudeau discloses an almost infinite number of oils list. Contrary to the applicant's argument, when one of ordinary skill in this art considers the disclosure and the teachings of Arraudeau as exemplified at column 2, lines 52 through column 3, lines 6-9, the oil would be envisioned, and therefore, anticipated. It is the position of the examiner that the almost infinite number of oil as argued by the applicant can be envisioned by the skilled artisan because Arraudeau teaches oils of animal, plant, or silicone oils as claimed by the applicant in claims 23-24.

Applicant argues that Arraudeau does not teach compatibilizing fiber. However, as disclosed in the previous rebuttal argument dated 11/21/01, Arraudeau does teach compatibilizing fiber.

Applicant argues that there is no clear teaching to select a compatibilizing fibers with a fatty phase and at least one polyol to compatibilize the fibers. The term "compatibilizing" has been given it's broadest interpretation, and the interpretation is being suitable for use in combination with. The claims do not require a chemical reaction but nearly a physical admixture. Allegation of a suitable fatty phase is not persuasive since the prior art does provide the fatty phase. Regarding polyol, prior art teaches polyol may be used and the resulting product being suitable for cosmetic application. The possible option suggested by the prior art is not

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considered to be of such a broad scope that one of ordinary skill in the art by routine experimentation, would not provide suitable formulation that includes compatible polyols. The term oil that is liquid at room temperature and chosen from hydrogenated oil, animal oil, plant oil, or silicone oil, it is reasonable to give the claims the broadest interpretation of the term "oil". The burden will be on the applicant to show some unexpected and/or unusual results that is obtainable using applicants' polyols that would not be obtainable by the prior art. Applicant desired a cosmetic to be homogeneous, does not migrate, and aesthetic. Arraudeau teaches perfect make-up products capable of maintaining their uniformity, prolonged period of wearing, and do not cause the formation of unaesthetic folds (column 1). Furthermore, there is no absolute correlation between the size of the prior art genus and a conclusion of obviousness; "One skilled in [the] art would ... envisage each member " of the genus. In re Petering, 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962) (emphasis in original). It is not seem that the undue burden would exist to one of ordinary skill in the art to provide a suitable cosmetic formulation having compatibilizing polyol.

Applicant argues that Arraudeau does not teach IOB values, and as a result, no *prima facie* case of obviousness has established. However, it is the position of the examiner that no criticality is seen in the particular IOB values since Arraudeau obtains the same result desired by the applicant, *e.g.*, perfect make-up products capable of maintaining their uniformity, prolonged period of wearing, and do not cause the formation of unaesthetic folds. Applicant has not

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provide any unexpected and/or unusual result in the use of the particular IOB values. See also *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235, (CCPA 1955).

Applicant argues that there's no reason to combine Arraudeau with Yoshioka. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yoshioka teaches stable capsule which is useful in the field of cosmetic. Moreover, Yoshioka is relied upon solely for the teaching of the IOB values.

Applicant argues that there's no suggestion to combine Arraudeau with Shiseido. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Shiseido teaches cosmetic material having good thermal effect comprising polymers having the claimed IOB values. Shiseido is relied upon solely for the teaching of the IOB values.

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Applicant argues that Franzke does not teach an anhydrous cosmetic composition. The term “anhydrous composition” is defined in applicant’s specification at page 5 as being “a composition comprising a homogeneous continuous fatty phase in which may be dispersed ingredients that are insoluble in the fatty phase, in the absence of surfactant or emulsifier, such as dyestuffs and cosmetic or dermatological active agents, including water. In particular, the water will be present in a content of not more than 6% relative to the total weight of the composition”. Applicant’s specification at page 15, further discloses the composition of the invention can also comprise any ingredients, such as dyestuffs, e.g., pigments; cosmetic or dermatological active agents, such as emollients, moisturizers, e.g., water. Franzke at column 3, lines 52-58 discloses water, wetting agents, or emulsifier agents in an amount of from 0.1 to 30% by weight, which clearly falls within the water content defines in the applicant’s specification.

Applicant argues that Franzke does not teaches a cosmetic composition comprises a homogenous continuous fatty phase, but a composition comprises ethanol. Contrary to the applicant’s argument, Franzke teaches a cosmetic composition comprising polyamide fiber having diameter of 8 to 70  $\mu\text{m}$ , length between 20 to 2000  $\mu\text{m}$  (column 1, lines 56 through column 2, lines 1-67; and example 18), glycols, silicone oil, and polymers (column 3, lines 1-36). Hence, Franzke does teach an anhydrous cosmetic composition comprising fiber and polyol. Applicant’s generic claims do not exclude the present of alcohols.

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Applicant argues that Franzke's examples discloses aqueous or ethanol base composition but not a homogenous continuous fatty phase. Franzke is relied upon for the teaching within the four walls patent. Franzke cannot be limited to his best mode as described in the examples.

Applicant argues that Bara cannot be combined with Arraudeau because Bara does not teach the use of fibers. Contrary to the applicant's argument, Bara was not cited for the teaching of fiber. Bara was relied upon solely for the teaching of parleam oil that can be in cosmetic composition. The obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

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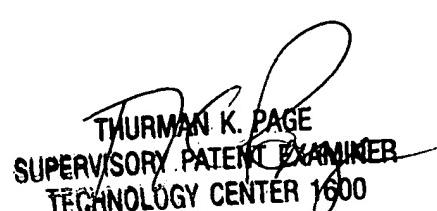
1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



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